

### **REMARKS**

Applicants respectfully request reconsideration of the present application. No new matter has been added to the present application. Claims 1-7, 9-25, 27 and 28 have been rejected in the Office Action. No claims have been amended or canceled in this Response. Accordingly, claims 1-7, 9-25, 27 and 28 are pending herein. Claims 1-7, 9-25, 27 and 28 are believed to be in condition for allowance and such favorable action is respectfully requested.

#### **Rejections based on 35 U.S.C. § 103**

Claims 1-7, 9-25, 27, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Netscape Communicator v 4.61 (the "Netscape Communicator reference") in view of Prizm Plug-in 2.1 (the "Prizm reference"), U.S. Patent No. 6,085,195 to Hoyt et al. (the "Hoyt reference"), and U.S. Patent No. 6,151,609 to Truong et al. (the "Truong reference"). As a *prima facie* case of obviousness has not been established, Applicants respectfully traverse this rejection, as hereinafter set forth.

#### **A. Applicable Authority**

The basic requirements of a *prima facie* case of obviousness are summarized in MPEP § 2143 through § 2143.04. In order "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)". See MPEP § 2143. Further, in establishing a *prima facie* case

of obviousness, the initial burden is placed on the Examiner. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972, (Bd. Pat App. & Inter. 1985)." *Id.* See also MPEP § 706.02(j) and § 2142.

B. References Fail to Teach or Suggest All Claim Limitations

Applicants respectfully submit that a *prima facie* case of obviousness has not been established because the combination of references cited in the Office Action fails to teach or suggest all the claim limitations for each of claims 1-7, 9-25, 27, and 28. Referring initially to independent claim 1, a method of modifying an image on a web page is recited. The method comprises establishing communication with a remote computer using at least one Internet protocol, downloading the web page from the remote computer, displaying the web page in a web-browser interface, presenting the image in an editing interface for modification by the user in response to the user selecting the image from the displayed web page directly from the web-browser interface, and saving the modified image as a modified source file on the remote computer replacing a source file of the image as downloaded.

In rejecting independent claim 1, the Examiner admitted that the combination of the Netscape Communicator and Prizm references fails to disclose the step of saving the modified image as a modified source file on the remote computer replacing a source file of the image as downloaded. See Office Action, at pg. 3. Accordingly, the Examiner appears to rely on the Hoyt and Truong references to disclose this limitation. However, as described in further detail as follows, the Hoyt and Truong references, either alone or in combination, fail to teach or

suggest “saving the modified image as a modified source file on the remote computer replacing a source file of the image as downloaded,” as required by independent claim 1.

The Hoyt reference discusses capturing a new image, allowing for the image to be modified, and saving the image file to a server. However, this file does not exist on the server prior to being saved and thus does not update or overwrite a source file on the server. Therefore, Hoyt fails to teach or suggest saving a modified image as a modified source file on a remote computer, thereby replacing a source file of the image as downloaded. In fact, the Examiner admits in the Office Action that “Hoyt does not teach the step of replacing the source file of the image as downloaded.” *See* Office Action, at pg. 5.

The Truong reference discusses a remote editor system for remotely editing the text of a selected file that is stored on a remote server. In response to a client request, a server sends the client an editor input form. Using the editor input form, a user at the client may indicate a server path that contains a file the user wishes to edit. The user may then submit the editor input form to the server. In response, the server generates and sends an editor selection form that includes the filenames of files included in the indicated server path. The user may then make a file selection input using the editor selection form. The server receives the selection and communicates the text of the selected file to the client. The user may then edit the text of the file and subsequently store the file on the server.

It is clear that the Truong reference fails to teach or suggest saving a modified image as a source file on a server, thereby replacing the source file of the image as downloaded. Instead, the Truong reference discloses modifying the text of a file and saving the modified text file to a server. The text of a file for a web page consists of the markup language used for the web page. For example, FIG. 5 and FIG. 6 of the Truong reference show HTML text files to be

modified using the system discussed in that reference. As explained beginning on page 1, line 11 of the specification for the instant application:

A markup language has commands and data structures that define the arrangement and content of the web page in a way that is understandable to a web browser. If a digitized photo, spreadsheet or other imported image is to be displayed in the web page, the definition of the image is typically stored in one or more source files outside of the markup language document. To allow a web browser to retrieve and display imported images, the web page may include a reference to the source file or files, such as a pointer or filename.

Therefore, the source file for an image is separate from the text file for the web page, which includes only a reference to that source file. The Truong reference discusses only modifying the text of a file for a web page and then saving the modified text file to a server. Because such a text file contains only a reference to a source file for an image and not the source file itself, it is impossible to use the system discussed in the Truong reference to save an image as a source file on a server, replacing the source file of the image as downloaded.

Accordingly, it is respectfully submitted that the Netscape Communicator, Prizm, Hoyt, and Truong references, either alone or in combination, fail to teach or suggest all of the limitations of independent claim 1. Therefore, a *prima facie* case of obviousness cannot be established for this claim based upon these references. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of independent claim 1 is respectfully requested.

Similar to independent claim 1, independent claim 14 recites the limitation: "saving the modified image as a modified source file on the computer replacing the source file of the image as downloaded." Likewise, independent claim 22 contains a similar limitation that requires "a means for saving a source file of the modified image to the remote computer replacing a source file of the image as downloaded." Therefore, these claims are believed to be in condition for allowance for at least the reasons cited above for independent claim 1.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of independent claims 14 and 22 is respectfully requested.

Each of claims 2-7 and 9-13 depends, either directly or indirectly, from independent claim 1. In addition, each of claims 15-21 depends, either directly or indirectly from independent claim 14. Further, each of claims 23-25, 27, and 28 depends, either directly or indirectly from independent claim 22. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness based upon the Netscape Communicator, Prizm, Hoyt, and Truong references, either alone or in combination, cannot be established for these claims for at least the same reasons as cited above. “‘If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.’ *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” MPEP § 2143.03. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of claims 2-7, 9-13, 15-21, 23-25, 27, and 28 is respectfully requested as well.

C. Lack of Suggestion or Motivation to Combine the Cited References

Applicants also respectfully submit that a *prima facie* case of obviousness has not been established for each of claims 1-7, 9-25, 27 and 28 because the Examiner has not set forth any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the Hoyt and Truong references with the Netscape Communicator and Prizm references.

“The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. ‘To support the conclusions that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.’ *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat App. & Inter. 1985).”

MPEP § 2142. MPEP § 2142 further states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *Dembiczak*, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. *Id.* at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. *In re Rouffet*, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).


The Examiner has not presented any evidence why the Hoyt and Truong references would have been combined with the Netscape Communicator and the Prizm references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. *Id.* The sole support provided in the Office Action for such a combination is that "[i]t would have been obvious to an artisan at the time of the invention to include the step of replacing the modified image source file onto the remote computer as taught by Hoyt and Truong with the method of Netscape and Prizm in order to update all changes that have been modified by the user to the source file for future use." Office

Action, pg. 3. The Examiner cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in any of the references, and the Examiner has not presented any actual evidence in support of the same. Instead, the Examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and should be withdrawn.

### CONCLUSION

For at least the reasons stated above, claims 1-7, 9-25, 27, and 28 are believed to be in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of claims 1-7, 9-25, 27, and 28. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. It is believed that no fee is due in conjunction with the present response. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

  
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